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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,282	01/11/2002	Chander P. Chawla	P 283276 D1144	4568
43569	7590	02/10/2006	EXAMINER	
MAYER, BROWN, ROWE & MAW LLP 1909 K STREET, N.W. WASHINGTON, DC 20006			GRAY, JILL M	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,282

Applicant(s)

CHAWLA

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

The rejection of claims 1-12 and 14-19 under 35 U.S.C. 102(e) as being anticipated by Chawla et al, 6,376,571 B1 is moot in view of applicants' amendments.

The rejection of claims 1-2 and 14-17 under 35 U.S.C. 102(e) as being anticipated by Bishop et al, US 2003/0018122 A1 is moot in view of applicants' amendments.

The rejection of claims 1-12 and 14-19 under 35 U.S.C. 102(e) as anticipated by or, in the alternative under 35 U.S.C. 103(a) as obvious over Montgomery et la, US 2002/0147248 A1 is moot in view of applicants' amendments.

The rejection of claims 1-10, 12, and 14-19 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bishop et al, 6,714,712 B2 is moot in view of applicants' amendments.

The rejection of claim 11 under 35 U.S.C. 103(a) as being obvious over Bishop et al 6,714,712 in view of Chawla et al, 6,376,571 B1 is moot in view of applicants' amendments.

The provisional rejection of claims 1 and 2 under the judicially created doctrine of obviousness-type double patenting is moot in view of applicants' amendments.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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2. Claims 1-2 and 22-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, the specifically, as originally filed, does not disclose the reactive diluent being present in amounts of "34 wt% to 99 wt%" or "50-99 wt%" as claimed in amended claims 1 and 2 and new claims 22-23.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12, 14-19, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chawla 6,376,571 B1 (Chawla), as applied in previous office actions.

Chawla is as applied previously but does not specifically teach a radiation curable copolymeric urethane oligomer. Nevertheless, it is the position of the examiner that the broad teaching of Chawla of urethane oligomers embraces all urethane oligomers, including copolymeric urethane oligomers. The skilled artisan would reasonably expect success at producing a radiation-curable optical fiber coating composition based upon the general level of skill and knowledge in the art at the time the invention was made, as evidenced by the teachings of Chawla, that radiation-

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curable urethane oligomers are known components in radiation-curable composition.

The selection of a copolymeric urethane oligomer is construed to be no more than a preferential selection of one urethane oligomer from among many, being selected for one of its art recognized functions. Furthermore, there is not clear factual evidence on this record of unexpected or superior properties of the instant claimed radiation-curable optical fiber coating composition, said unexpected or superior properties being directly related to the copolymeric urethane oligomer.

Regarding the amount of reactive diluent, Chawla teaches that the reactive diluent can be present in an amount up to about 33 wt%. The language of "about 33 wt%" means that exactitude is not being claimed and includes amounts greater than 33wt%. Accordingly, it is the examiner's position that an amount of "up to about 33 wt%" is sufficiently close to the instant claimed "34 wt%" that the skilled artisan would expect the properties of the prior art composition to be the same as or similar to that of the instant claimed invention.

Therefore, the teachings of Chawla would have rendered obvious the invention as claimed in present claims 1-12, 14-19, and 20-21.

Response to Arguments

5. Applicant's arguments with respect to claims 1-12 and 14-19 have been considered but are moot in view of the new ground(s) of rejection.

No claims are allowed.

Conclusion

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6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

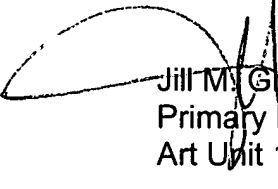
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray
Primary Examiner
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jmg